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NO. 179 P. 1

SEP 29 2006

Serial No.: 10/047,827
Atty. Docket No.: D5110

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

In re Patent Application of:

THOMPSON, Jason R.

Serial No.; 10/047,827

Filed: 29 September 2001

Group Art Unit: 3618

Examiner: ROSENBERG

For: **UNIVERSAL ACCESSORY-MOUNTING ASSEMBLY**

REPLY TO EXAMINER'S ANSWER

VIA FACSIMILE: (571) 273-8300
Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

This paper is in reply to the Examiner's Answer, mailed 9 August 2006.

Several points raised by the Examiner are responded to here, basically in the order presented in the Examiner's Answer. Claims 1-40 were rejected in the original application, based on each of two combinations of references: (1) Applicant's Admitted Prior Art (AAPA) in view of Rawlinson '093 patent, or (2) the Murgas '883 patent in view of Rawlinson. It has been and remains the chief contention of the applicants that no valid basis for modification of either the AAPA or the Murgas '883 patent by the Rawlinson '093 patent based on teachings found in the prior art has been advanced.

Murgas teaches a three point connection mirror-mounting unit (col. 1, lines 10-12). The Examiner contended that "the three support components (16, 20, 28) [are] engaged to each other in such a manner that they are selectively movable relative to each other . . .".(See Page 5). The strongest support for this view appears in the patent at col. 2, lines 20-24, where it states: "The brace 20 is pivoted by a clamping bolt and nut 24 to a clamp 26 surrounding the tube 16. By loosening this bolt and nut the clamp

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26 may be adjustably positioned along the tube 16 to change the angle of the tube 16 laterally with respect to the brace 22." However, there are features of Murgas, highlighted by reference to Fig. 2 of the patent reproduced to the left, which limit the freedom of movement of the support components. A longitudinal brace 22, riveted at each end to ends of two of the "support components" (tube 16 and a brace 20), is one such feature. Brace 22 fixes the spacing between the hood feet 36. Brace 22 obviously limits the relative movement allowed support components 16 and 20. Brace 20 can pivot on tube 16 only if brace 22 is pivotable on rivet 23, but the patent is silent on whether tube 16 and brace 20, respectively, can rotate on rivets 23, which are described in the specification as being secure (col. 2, lines 15-19). If the points of attachment between tube 16 and brace 22 to brace 20 and brace 22 are "secure" in the strong sense of the word, the triangle formed between tube 16, brace 22 and brace 20 is fixed, meaning the angle between brace 20 and tube 16 is also fixed. Further, any travel clamp 26 has on tube 16 would appear limited by the position of clamp 32 on tube 16, and the need to fit the overall device to a fender.

The Examiner also cites the Murgas '883 patent as teaching three "independent base attachment structures 34, 36 engaged to the base end of each support component . . .". The base attachment structures are taken to be the fender foot 34 and the hood feet 36 shown in the drawing reproduced above. It is unclear to the applicants what is meant by terming the attachment structures as "independent" other than to suggest that other attachment structures could be freely substituted for those shown without affecting operation of the invention of the Murgas patent. This leads to the dispute between the Examiner and the Applicant on the amenability of the Murgas structure for the proposed modification, that is, substituting two-axis pivoting connections between the attachment structures and the support structures for the rivets Murgas used.

The Examiner and the applicant obviously disagree on whether the "attachment structures" in Murgas could be attached to their respective base legs/support structures using ball and socket joints without defeating Murgas functionally. It remains applicant's

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contention that allowing the attachment structures rotational freedom of movement, particularly on an axis transverse to the direction the tension supplied by the rubber clamp, could allow at least the hood feet to rotate away from the hood crease. On this point the Examiner pointed to Fig. 3 of Murgas as proof that pivotable feet would fixedly engage the base structure, "the stepped portion [of hood feet 36 having] a flat mounting-face which is firmly pressed against the base structure . . .". The question though is whether the feet would rotate to relieve tension in clamping rubber 40. Here it should be noted that the structure does not foreclose rotation. Murgas at col. 2, lines 32-38 states that:

The inner ends of the upper triangle have stepped hood feet 36 which are best as shown in Fig. 3 to engage the inner face 38 of the edge of the fender forming the motor well. No screws or other fastening means are used to secure the feet 36 to such edge. Thus, the motor hood 39 can be opened and closed without disturbing the mounting 14. (Emphasis supplied).

The Examiner is in effect arguing that the feet *could* be used to attach feet and legs which is not clearly shown. Certainly no reason to use pivotable connections between the fender and hood feet and their respective support legs has been advanced.

Regarding the Rawlinson '093 patent, applicant maintains that the reference cannot teach a "universal accessory-mounting assembly" where the accessory is an essential element of the assembly. There is no assembly without the accessory.

Regarding modification of Applicant's Admitted Prior Art in view of Rawlinson the examiner cites to the Rawlinson '093 patent as providing the needed teaching at col. 5, lines 24-27. Looking at the cited language in broader context (col. 5, lines 24-32) is constructive:

The ball 50 allows the clamps 51 to adapt to all *windshields* on the market [emphasis supplied, the adaptability of the device to differing windshields at two points of support is not the same as adaptability to differing base

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design structures at three points of support]. The ball 50 is necessary because most windshields have compound angles. One of the features of the mounting arrangement 26 . . . is that it permits the mirror to pivot up for use and back down for covering and trailering of the boat. The multi-axis pivot . . . permits the mirror to move up and down without any binding forces.

Rawlinson is clearly limited to the context of two points of support while preserving an angle of rotation for the structure to permit stowage.

Applicants submit that they have shown that the Examiner has failed to make a *prima facie* case of obviousness and the rejections should therefore be overturned.

Respectfully submitted,



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CERTIFICATE OF TRANSMISSION UNDER 37 CFR §1.8

I hereby certify that this REPLY TO EXAMINER'S ANSWER is being facsimile transmitted to the Patent and Trademark Office on or before 9/29/06 to (571) 273-8300.

Date: 9/29/06



Catherine M. Majewski